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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/700,215	11/03/2003	Richard G. Sevier	200311063-1	3095

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EXAMINER

STOREY, WILLIAM C

ART UNIT	PAPER NUMBER
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2625

NOTIFICATION DATE	DELIVERY MODE
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05/13/2008

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary	Application No. 10/700,215	Applicant(s) SEVIER, RICHARD G.	
	Examiner WILLIAM C. STOREY	Art Unit 2625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 April 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,4-10,20,23-29,39 and 50 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,4-10,20,23-29,39 and 50 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

In view of the appeal brief filed on 4/22/2008, PROSECUTION IS HEREBY REOPENED. New grounds of rejection are set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) initiate a new appeal by filing a notice of appeal under 37 CFR 41.31 followed by an appeal brief under 37 CFR 41.37. The previously paid notice of appeal fee and appeal brief fee can be applied to the new appeal. If, however, the appeal fees set forth in 37 CFR 41.20 have been increased since they were previously paid, then appellant must pay the difference between the increased fees and the amount previously paid.

A Supervisory Patent Examiner (SPE) has approved of reopening prosecution by signing
below:

Claim Rejections - 35 USC § 103

1. Claim 1 rejected under 35 U.S.C. 103(a) as being obvious over Connolly (US 6169873).
2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Regarding claim 1, Connolly discloses scanning that may scan up to two sides, and that analysis of a page's pixels is performed, and that the scanner provides images of the sides of sheets intended for image transfer (fig. 1, col. 5, lines 13-29, lines 54-67). It is well known to those of ordinary skill in the art to obtain digital images from scans for image transfer (obtaining a first digital image of a first side of a physical object (paper)). The physical object is a first of an ordered set of physical objects (fig. 1); examining the first digital image to determine if it is substantially blank (col. 6, lines 28-31. Since a determination is done to see if images appear on one or two sides of first pages, it is inherent that the first digital image be determined if it is substantially blank in this context (col. 5, lines 54-63);

Although Connolly did not distinctly disclose checking only one image for face orientation, and then making the assumption for the rest of the sheets in the stack. Connolly disclosed fig. 2, col. 6, lines 12-67, col. 7, lines 1-20. Connolly disclosed checking 3 pages as a preferred embodiment before a determination of a page orientation was made. However, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide checking only one image for face orientation, and then making the assumption for the rest of the sheets in the stack for the purpose of increasing speed. The checking of additional pages is an improvement that allows for error reduction and the system could easily be implemented by only checking one page.

In addition, the current invention discusses simplex or duplex detection whereas the instant claim does not particularly refer to such a distinction. Col. 5, lines 41-44 disclose even for duplex scanning one side of a sheet of duplex documents may be scanned at a time. It would have been obvious to implement the well known method of duplex scanning in order to increase speed without having to preclude possible information on a second side of a sheet.

if the first side is not substantially blank, obtaining a first set of digital images, each digital image of the first set being a digital image of a first side of a physical object of the ordered set of physical objects (col. 5, lines 41-44, col. 7, lines 5-10, previous discussions. Inherently a stack of sheets is ordered.), and, sending the first set of digital images for processing (col. 7, lines 13-15); and if the first digital image is substantially blank, obtaining a second set of digital images, each digital image of the second set being a digital image of a second side of a physical object of the ordered set of physical objects, and sending the second set of digital images for processing (fig. 2, col. 6, lines 12-67, col. 7, lines 1-20, and similar to previous discussion for other side).

Regarding claim 4, the claim inherits everything as applied above for claim 1. In addition, Connolly discloses fig. 2, col. 6, lines 54-64, col. 7, lines 5-10. This shows that there is a pause after the first side is examined for determination of blankness, before a confirmation to go ahead and use the images on the reverse side (obtain second set of digital images). Although Connolly did not distinctly disclose obtaining the second set of digital images *only* if the first digital image is substantially blank, it would have been obvious to provide removing the improvement of duplex determination or scanning in

Art Unit: 2625

order that obtaining the second set of digital images occurs *only* if the first digital image is substantially blank for the purpose of allowing the invention to be easier to be less complicated.

Regarding claim 5, the claim inherits everything as applied above for claim 1. Although Connolly did not distinctly disclose discarding the first digital image if is substantially blank, Connolly disclosed col. 7, lines 53-55. It would have been obvious to one of ordinary skill at the time the invention was made to provide discarding the first digital image if is substantially blank for the purpose of the output of the scanner not requiring as much space or transmission time.

Regarding claim 6, the claim inherits everything as applied above for claim 1. It was disclosed previously scanning the sheets in order to generate images, thus, reading on the claim.

Regarding claim 7, the claim inherits everything as applied above for claim 1. Although Connolly did not distinctly disclose sending the not substantially blank side of images to be printed, Connolly disclosed col. 5, line 19, line 67, claim 7. It would have been obvious to one of ordinary skill at the time the invention was made to provide sending the not substantially blank side of images to be printed for the purpose of having an extra copy of information in case the first copy get lost.

Regarding claim 8, the claim inherits everything as applied above for claim 1. Although Connolly did not distinctly disclose sending the not substantially blank side of images to be facsimile transmitted, Connolly disclosed col. 7, lines 37-41, col. 5, line 15. It would have been obvious to one of ordinary skill at the time the invention was made to

provide sending the not substantially blank side of images to be facsimile transmitted for the purpose of having allowing someone far away to see the printed information.

Regarding claim 20, the claim is rejected based upon similar reasoning as applied above for claim 1. Changing the claim from one category of invention to another does not make the claim patentably distinct.

Regarding claim 23, the claim is rejected based upon similar reasoning as applied above for claim 4. Changing the claim from one category of invention to another does not make the claim patentably distinct.

Regarding claim 24, the claim is rejected based upon similar reasoning as applied above for claim 5. Changing the claim from one category of invention to another does not make the claim patentably distinct.

Regarding claim 25, the claim is rejected based upon similar reasoning as applied above for claim 6. Changing the claim from one category of invention to another does not make the claim patentably distinct.

Regarding claim 26, the claim is rejected based upon similar reasoning as applied above for claim 7. Changing the claim from one category of invention to another does not make the claim patentably distinct.

Regarding claim 27, the claim is rejected based upon similar reasoning as applied above for claim 8. Changing the claim from one category of invention to another does not make the claim patentably distinct.

Regarding claim 39, the claim is rejected based upon similar reasoning as applied above for claim 1. The system simply provides structure for the method of claim

1 and is not patently distinct; thus, claim 39 is rejected for the same reasons as stated above in the rejection of claim 1. Specifically, Connolly discloses a scanning device (col. 5, lines 13-29) which may read on claimed image manager and content module.

Regarding claim 50, the claim is rejected based upon similar reasoning as applied above for claim 39. The “means for” providing the functions in the claim may be read upon by the scanning device.

3. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Connolly as applied to claim 1 above, and further in view of Garcia (US Publication Application Publication 2003/0048470).

Regarding claim 9, the claim inherits everything as applied above for claim 1. Although Connolly did not distinctly disclose sending images to be email transmitted, Connolly disclosed col. 7, lines 37-41, col. 5, line 15 which show long distance image data transfer capabilities.

In addition, in a similar field of endeavor, Garcia discloses a multi-function peripheral, including a scanning function. Garcia describes scanning documents to create a digital image of a document and an email function that permits electronic mailing of the digital image, as disclosed in paragraph 29.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Connolly by specifically providing sending images to be email transmitted, as taught by Garcia, for the purpose of allowing someone far away to see the printed information that was scanned by the system.

Regarding claim 28, the claim is rejected based upon similar reasoning as applied above for claim 9. Changing the claim from one category of invention to another does not make the claim patentably distinct.

4. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Connolly as applied to claim 1 above, and further in view of Okubo (US Patent Application Publication 2005/0200903) and Nakano (US Patent Application Publication 2004/0145770).

Regarding claim 10, Connolly discloses everything claimed as applied above in claim 1.

However, Connolly did not disclose outputting image data to a computer. In a similar field of endeavor discloses a system that eliminates blank pages from image output. In addition, Okubo discloses that the data output unit 17 may send the image data to an external device such as a personal computer, as disclosed in paragraph 30.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Connolly by specifically providing outputting data to a computer as taught by Nakano, for the purpose of allowing for more user interaction with the images and the ability to store the images for later use.

However, Connolly and Okubo do not distinctly archival of the image file. In a similar field of endeavor, Nakano discloses archiving of digital images in a multi-function device system. Nakano discloses copying or moving a digital image to an archive directory on a desktop computer, server, or removable medium, as disclosed in paragraph 25.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Connolly and Okubo by specifically providing archiving of digital images, as taught by Nakano, for the purpose of allowing better management of digital images, as disclosed in paragraph 4.

Regarding claim 29, the claim is rejected based upon similar reasoning as applied above for claim 10. Changing the claim from one category of invention to another does not make the claim patentably distinct.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to WILLIAM C. STOREY whose telephone number is (571)270-3576. The examiner can normally be reached on Monday - Friday Eastern Standard Time.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, King Y. Poon can be reached on (571) 272-7440. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2625

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/William C Storey/
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